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| 09/629,904 | 07/31/2000 | Douglas B. Quine | F-179 | 5048 |

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| EXAMINER |
|---|
| BAYARD, DJENANE M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2141 | |

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/629,904 | Applicant(s) QUINE, DOUGLAS B. |
|---|---|---|
| | Examiner Djenane M Bayard | Art Unit 2141 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 June 2004*.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *17-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/27/04*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

## DETAILED ACTION

### *Response to Amendment*

1.     This is in response to amendment filed on December 09, 2004 in which claims 17-32 are

pending.  Applicant's request for reconsideration of the finality of the rejection of the last Office

action is persuasive and, therefore, the finality of that action is withdrawn.

### *Response to Arguments*

2.     Applicant's arguments, with respect to the rejection(s)of claim(s) 17-32 have been fully

considered and are persuasive.  Therefore, the rejection has been withdrawn.  However, upon

further consideration, a new ground(s) of rejection is made with U.S. Patent No. 6,438,583 to

McDowell et al in view of U.S. Patent No. 6,389455 to Fuisz.

### *Double Patenting*

3.     Claims 17, 19, 20, 24, 27, 31 and 32 of this application conflict with claims 10-12, 14,

19, 21 and 22 of copending Application No. 09/629909.  37 CFR 1.78(b) provides that when two

or more applications filed by the same applicant contain conflicting claims, elimination of such

claims from all but one application may be required in the absence of good and sufficient reason

for their retention during pendency in more than one application.  Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of demarcation

between the applications.  See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.  See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

| A method for transmitting an e-mail message intended for a non-preferred e-mail address to a preferred e-mail address, the method comprising the steps of: receiving the e-mail message at a second address wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address; parsing the non-preferred e-mail address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address; and sending the e-mail message from the second address to the preferred e-mail address | A method for transmitting an e-mail message comprising the steps of: receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address; parsing the non-preferred e-mail address data from the e-mail message at the intermediate address and determining if there is preferred e-mail address data associated with the non-preferred e-mail address data; **storing at a location associated with intermediate address, the non-preferred e-mail address data when it is determined that there is no** |

| | **preferred e-mail address data associated with the non-preferred e-mail address data.** |
| --- | --- |
| | |

4.      Claims 17, 19, 20, 24, 27, 31 and 32 provisionally rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claims 10-12, 14, 19,

21 and 22 of copending Application No. 09/629909 in view of U.S. Patent No. 6,389455 to

Fuisz. After analyzing the language of the claims, it is clear that claims 17, 24, 31 and 32 of the

09/629904 application are merely an obvious variation of claims 10, 14, 21 and 22 of the

09/626909 application. While claims of the 09/629909 patent Application are slightly broader,

the difference is not enough to distinguish the two set of claims. With respect to the "storing at a

location the non-preferred e-mail address data when it is determined that there is no preferred e-

mail address data associated with the non-preferred e-mail address data" the language and the

disclosure of the 09/626904 application not only fail to distinguish it from the 09/629909

application, but indicate that it is merely a subset of the 09/629909 application. The differences

are sufficient to render the claims patentably distinct.

This is a provisional obviousness-type double patenting rejection.

*Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.      Claims 17-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent

No. 6,438,583 to McDowell et al in view of U.S. Patent No. 6,389455 to Fuisz.

a.      In regard to claim 17, McDowell discloses a method for transmitting an e-mail message

comprising the steps of: receiving the e-mail message at an intermediate address, the e-mail

message including non-preferred e-mail address data (See col. 1, lines 51-53) the e-mail message

having been previously transmitted to an invalid e-mail address and transmitted back to a sender

e-mail address (See Col. 6, lines 31-37, It is common practice of many ISP to bounce

undeliverable e-mails back to the sending computer); parsing the non-preferred e-mail address

data from the e-mail message at the intermediate address and determining if there is preferred e-

mail address data associated with the non-preferred e-mail address data (See col. 8, lines 7-11);

However, McDowell et al  failed to disclose storing at a location associated with intermediate

address, the non-preferred e-mail address data when it is determined that there is no preferred e-

mail address data associated with the non-preferred e-mail address data.

        Fuisz teaches a method and apparatus for bouncing electronic messages. Furthermore,

Fuisz wherein limited storage is available for users who do not have a forwarding address that is

presently available (See col. 7, lines 56-60).

        It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to incorporate storing at a location associated with intermediate address, the non-

preferred e-mail address data when it is determined that there is no preferred e-mail address data

associated with the non-preferred e-mail address data as taught by Fuisz into the claimed

invention of McDowell et al in order to store all e-mails arriving until they are retrieved (See

col. 7, lines 60-65).


b.      In regard to claim 24, McDowell et al discloses a method for transmitting an e-mail

message that has been sent from a sender address to a previously-known recipient e-mail address

and rejected at the previously-known recipient e-mail address and transmitted back to the sender

address, the method comprising the steps of: receiving the rejected e-mail message at an

intermediate address (See col. 8, lines 33); determining a preferred recipient e-mail address from

the rejected e-mail message (See col. 8, lines 7-11). However, McDowell et al failed to disclose

storing at a location associated with the intermediate address, the previously-known recipient e-

mail address when it is determined that there is no preferred recipient e-mail address associated

with the previously-known recipient e-mail address.

Fuisz teaches a method and apparatus for bouncing electronic messages. Furthermore,

Fuisz wherein limited storage is available for users who do not have a forwarding address that is

presently available (See col. 7, lines 56-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to incorporate storing at a location associated with intermediate address, the non-

preferred e-mail address data when it is determined that there is no preferred e-mail address data

associated with the non-preferred e-mail address data as taught by Fuisz into the claimed

invention of McDowell et al in order to store all e-mails arriving until they are retrieved (See col. 7, lines 60-65).

c.     In regard to claim 18, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting the e-mail message to the preferred e-mail address when preferred e-mail address data is associated with the non-preferred e-mail address data (See col. 8, lines 7-11).

d.     In regard to claim 19, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell et al discloses the method further comprising the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message has been sent to the preferred e-mail address (See col. 14, lines 40-43).

e.     In regard to claim 20, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of sending a return e-mail message to a sender address from the intermediate address indicating that the e-mail message was not forwarded to the preferred e-mail address (See col. 14, lines 40-43)

f.     In regard to claim 21, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell discloses a method further comprising indicating to the sender that the intermediate address will withdraw the e-mail message upon receiving a request from the sender address (See col. 12, lines 55-58).

g.     In regard to claim 22, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting an e-mail message to the preferred e-mail address indicating that a user at a sender e-mail address is attempting to transmit an e-mail message to the non-preferred e-mail address (See col. 8, lines 41-43).

h.     In regard to claims 23 and 30, McDowell et al in view of Fuisz discloses the claimed invention as described above. However, McDowell failed to disclose the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data.

Fuisz discloses the storing step further comprising the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data (See col. 7, lines 56-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of storing the non-preferred e-mail address data until a recipient registers the preferred e-mail address data as taught by Fuisz into the claimed invention of McDowell et al in order to automatically forward the User's e-mail to the user's pre-selected forwarding e-mail address (See col. 1, lines 55-60).

i.     In claim 25, McDowell et al in view of Fuisz discloses the claimed invention as described above. Furthermore, McDowell et al discloses the step of transmitting the e-mail message to the

preferred recipient e-mail address when a preferred recipient e-mail address is associated with

the previously-known recipient e-mail address (See col. 8, lines 7-11).


j.      In regard to claim 26, McDowell et al in view of Fuisz discloses the claimed invention as

described above. Furthermore, McDowell et al discloses the method further comprising the step

of sending a return e-mail message to a sender address from the intermediate address indicating

that the e-mail message has been sent to the preferred recipient e-mail address (See col. 12, lines

14-17).


k.      In regard to claim 27, McDowell et al in view of Fuisz discloses the claimed invention as

described above. Furthermore, McDowell et al discloses the step of sending a return e-mail

message to a sender address from the intermediate address indicating that the e-mail message

was not forwarded to the preferred e-mail address (See col. 14, lines 40-43)


l.      In regard to claim 28, McDowell et al in view of Fuisz discloses the claimed invention as

described above. Furthermore, McDowell discloses a method further comprising indicating to

the sender that the intermediate address will withdraw the e-mail message upon receiving a

request from the sender address (See col. 12, lines 55-58).


m.      In regard to claim 29, McDowell et al in view of Fuisz discloses the claimed invention as

described above. Furthermore, McDowell et al discloses the step of transmitting an e-mail

message to the preferred e-mail address indicating that a user at a sender e-mail address is

attempting to transmit an e-mail message to the non-preferred e-mail address (See col. 8, lines

41-43).

n.      In regard to claim 31, McDowell discloses a method for transmitting an e-mail message

that was sent from a sender address to a previously-known recipient e-mail address that is

associated with a first service provider, and rejected at the previously-known recipient e-mail

address (See col. 1, lines 50-53) and transmitted back to the sender address (See col. 6, lines 31-

37), the method comprising the steps of: receiving the rejected e-mail message at a second

address; determining whether there is a preferred recipient e-mail address, that is associated with

a second service provider, from the rejected e-mail message (See col. 8, lines 7-11). However,

McDowell et al failed to disclose storing at a location associated with the intermediate address,

the previously-known recipient e-mail address when it is determined that there is no preferred

recipient e-mail address associated with the previously-known e-mail address.

Fuisz teaches a method and apparatus for bouncing electronic messages. Furthermore,

Fuisz wherein limited storage is available for users who do not have a forwarding address that is

presently available (See col. 7, lines 56-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to incorporate storing at a location associated with intermediate address, the non-

preferred e-mail address data when it is determined that there is no preferred e-mail address data

associated with the non-preferred e-mail address data as taught by Fuisz into the claimed

invention of McDowell et al  in order to store all e-mails arriving until they are retrieved (See

col. 7, lines 60-65).

o.     In regard to claim, 32, McDowell et al discloses a method for transmitting an e-mail

message that has been sent form a sender address to a second address, rejected at the second

address and transmitted back to the sender address (See col. 6, lines 31-37), the e-mail message

including a non-preferred e-mail address associated with a first preferred e-mail address

associated with a first service provider (See col. 1, lines 50-53), the method comprising the steps

of: receiving the e-mail message at an intermediate address; parsing the e-mail message to

obtain the non-preferred e-mail address from the e-mail message; determining whether there is a

preferred e-mail address, that is associated with a second service provider, from the non-

preferred e-mail address (See col. 8, lines 7-11). However, McDowell et al failed to disclose

storing at a location associated with the intermediate address, the non-preferred recipient e-mail

address when it is determined that there is no preferred recipient e-mail address associated with

the non-preferred e-mail address.

Fuisz teaches a method and apparatus for bouncing electronic messages. Furthermore,

Fuisz wherein limited storage is available for users who do not have a forwarding address that is

presently available (See col. 7, lines 56-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to incorporate storing at a location associated with intermediate address, the non-

preferred e-mail address data when it is determined that there is no preferred e-mail address data

associated with the non-preferred e-mail address data as taught by Fuisz into the claimed

invention of McDowell et al in order to store all e-mails arriving until they are retrieved (See

col. 7, lines 60-65).

## *Conclusion*

7.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Djenane M Bayard whose telephone number is (571) 272-3878.

The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rupal Dharia can be reached on (571) 272-3880.  The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system.  Status information for published applications

may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished

applications is available through Private PAIR only.  For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER